

R E M A R K S

Claims 1-44 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Provisional Obviousness-type double patenting rejection

The Examiner has provisionally rejected claims 1-4 and 30 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1, 2, 4 and 5 of co-pending application Number 10/205,628. Applicants traverse and note that this is the only rejection present in the present application.

A "provisional" double patenting rejection should continue to be made by the Examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the Examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in

the other application(s) into a double patenting rejection at the time the one application issues as a patent. See MPEP § 804(I)(B).

Thus, pursuant to USPTO procedure, the Examiner should allow this application to issue and then apply the obviousness-type double patenting rejecting in co-pending application No. 10/205,628.

However, the application of this rejection is improper regardless of the above. For instance, the claims of copending application No. 10/205,628 require an image receiving layer containing 1) a precipitated calcium carbonate (PCC)-containing image receiving layer, 2) a polyvinylpyrrolidone (PVP)-containing image receiving layer, or 3) both PCC and PVP (PCC/PVP). The rejected claims 1-4 and 30 do not require such a specialized image receiving layer. Moreover, there is no indication that such an image receiving layer would have been obvious. The fact that claim 4 of the copending application requires a transfer blocking overcoat is irrelevant.

Accordingly, Applicant submits that the above rejection over copending application No.: 10/205,628 is improper. Regardless, such a rejection should be withdrawn in the present application since it is the last remaining rejection. Reconsideration and withdrawal of this rejection is respectfully requested.

Allowable Subject Matter

The Examiner has indicated that claims 11-29 are allowed. Additionally, the Examiner indicates that claims 5-10 would be allowed if rewritten into independent format. However, since the only rejection is the provisional obviousness-type double patenting rejection, which should be withdrawn as discussed above, claims 5-10 should also be allowable.

Additionally, Applicant requests that the Examiner rejoin claims 31-44. Rejoinder is explained in MPEP§ 821.04 as follows: Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. See MPEP §806.05(f) or §806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. §1.142. See MPEP§ 809.02(c) and §§821 through 821.03. However, if applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

In the present instance, withdrawn claims 31-44 relate to processes of using the products of the allowed claims. Each group of process claims depend either directly or indirectly upon an allowed product claim. For instance, claim 31 depends upon claim 1, claim 35 depends upon claim 11, claim 39 depends upon claim 21, claim 43 depends upon claim 29 and claim 44 depends upon claim 30. Other dependent process claims depend upon the claims listed above. Accordingly, pursuant to the above discussion, Applicants request rejoinder of the withdrawn claims, that is, claims 31-44.


In summary, all currently pending claims are in condition for allowance. Applicant therefore requests that the Examiner withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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